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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/801,883 | 03/08/2001 | Gerbrand Deetman | 12598.0131CNUS00 | 7184 |

30954 7590 05/14/2003

LATHROP & GAGE LC
2345 GRAND AVENUE
SUITE 2800
KANSAS CITY, MO 64108

EXAMINER

OGDEN JR. NECHOLUS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1751 | |

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,883

Applicant(s)

DEETMAN, GERBRAND

Examiner

Necholus Ogden

Art Unit

1751

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 90-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 90-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

Reissue Applications

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

Applicant has not established ownership interest in the patent for which the reissue is being requested (i.e. 09/801,883). Applicant has submitted evidence with respect to the parent reissue application but has not satisfied the requirements for the present reissue case before the office.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

2. The original patent---37 CFR 1.178.

Applicant has surrendered the original patent (5,464,551) in conjunction with the allowance and issuance of the parent reissue application no. 08/966,425.

3. Maintenance Fees.

Applicant's maintenance fees are current until 2003.

4. Oath/Declaration

Applicant states that a revised copy of the declaration of reissue 08/966,425 has been submitted, which corresponds to claims 90-104 of the present reissue application.

The examiner contends that applicant has not satisfied the requirements of 37 C.F.R. 1.175(b) because applicant has to submit a new Oath/Declaration for the present reissue application.

Claim Rejections - 35 USC § 112

3. Claims 90 and 104 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn.

4. Claims 90-106 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application.

5. Applicant argues that they ".....mistakenly chose to amend the claims to recite this limitation."

6. The examiner contends that a claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. The courts have held that said reissue claims are invalid on grounds of improper recapture of the subject matter

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surrendered during prosecution to avoid prior art rejections, since reissue claims eliminated the substantially C4 or C5 isoalkyl base stock material limitations, and thus is broader than the corresponding claim of the original patent, since this broadened aspect of the claim relates to surrendered subject matter during prosecution of original application, and since recapture was not avoided by addition, on reissue, of C4 or C5 isoalkyl base stock material. Moreover, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution the flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." Accordingly, applicant is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections. *Pannu v. Storz Instruments Inc.*, 59 USPQ2d 1597; *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998); see also *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525.

Claim Rejections - 35 USC § 103

Claims 90-104 rejected under 35 U.S.C. 103(a) as being unpatentable over Mackinnon (4,206,067) in view of Smith (3,679,587) and further in view of Great Britain (1,370,728) and French (2,120,127) is withdrawn in view of applicant's arguments.

Claims 90-104 rejected under 35 U.S.C. 103(a) as being unpatentable over Skydrol ® LD-4, in view of MacKinnon (4,206,067) and further in view of Great Britain (1,370,728) and French (2,120,127) is withdrawn in view of applicant's arguments.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholas Ogden whose telephone number is 703-308-3732. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Nicholas Ogden
Primary Examiner
Art Unit 1751

no
April 3, 2003